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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,079	02/26/2002	Dominik Schutz	TRW(ASG)6052	4699

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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 04/15/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/083,079

Applicant(s)

SCHUTZ

Examiner

Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/1/03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/26/02 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:

- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Vinh T. Luong
Primary Examiner

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1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because of the implied phrase "The invention relates to . . ." Correction is required. See MPEP § 608.01(b).
3. The drawings are objected to because the drawings are inconsistent with the specification and the claims. For example, claim 1 claims the foam casing 12, however, Fig. 1 shows that the element 12 is made of sand or the like in accordance with the drawing symbols for draftspersons in MPEP 608.02. Similarly, claim 5 calls for the plastic housing 16, however, Figs. 1-5 do not show the drawing symbol for plastic in MPEP 608.02. Applicant is respectfully urged to comply with the drawing symbols approved by American National Standards Institute, Inc. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the foam casing in claim 1 and the plastic housing in claim 5 must be shown or the features canceled from the claims. No new matter should be entered.

Fig. 1 shows that the element 12 is made of sand or the like in accordance with the drawing symbols for draftpersons in MPEP 608.02. Similarly, claim 5 calls for the plastic housing 16, however, Figs. 1-5 do not show the drawing symbol for plastic in MPEP 608.02.

5. The disclosure is objected to because of the following informalities: the specification and the claims are inconsistent with the drawings. For example, claim 1 claims the foam casing 12, however, Fig. 1 shows that the element 12 is made of sand or the like in accordance with the drawing symbols for draftpersons in MPEP 608.02. Similarly, claim 5 calls for the plastic housing 16, however, Figs. 1-5 do not show the drawing symbol for plastic in MPEP 608.02. Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms, such as, "displaceable" in claim 1 and "nonremovable" in claim 8 are vague and indefinite in the sense that things which may be done are not required to be done, *e.g.*, in claim 1, the covering cap is *displaceable*, but is not required structurally to be displaced in an axial direction. See "crimpable" and "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif.

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1986); "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992) and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4 and 6-11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bohn et al., i.e., EP 0 945 310 A2 (which corresponds to US Patent No. 6,312,012 B1).

The examiner respectfully submits that in the rejection below, the examiner refers to Pat.'012 to facilitate its understanding only since Pat.'012 is published in English. The rejection is based on EP 0 945 310 A2 because the publication date of EP'310 (September 29, 1999) was earlier than the publication date of Pat.'012 (November 6, 2001).

Regarding claim 1, Bohn teaches a vehicle steering wheel, comprising

a skeleton 1-3 embedded in a foam casing 4 and a covering cap 6 having an edge 24 (Fig. 1),

said covering cap 6, for actuation of a horn (see line 35 et seq., column 1 of Pat.'012), being mounted so as to be *displaceable* in an axial direction (see lines 15-20, column 4 of Pat.'012), said foam casing 4 of said skeleton 1-3 adjoining said edge 24 of said covering cap 6,

guides 10 or 10,26 for said covering cap 6 being provided in a region of said edge 24 of said covering cap 6, said guides 10 or 10,26 being arranged such that and elastically mounted such

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that upon laterally pressing down said covering cap 6 for actuating said horn, said guides 10 or 10, 26 are inherently tilted allowed by a yielding of said foam casing 4.

Claim 1 and other claims below are anticipated by Bohn since Bohn teaches each positive claimed element. On the other hand, note that the term "displaceable" is a relative term, particularly since virtually any thing will be displaced if enough force or pressure is applied to it. See "flexible" or "flexibility" in *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC NIII 1969). Moreover, applicant's recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, a gas bag module 5 is provided which is closed by said covering cap 6 and which together with said covering cap 6 is mounted so as to be displaceable in said axial direction, said guides 10 or 10,26 being connected with said gas bag module 5. See line 5 et seq., column 3 of Pat.'012.

Regarding claim 3, said gas bag module 5 has a cup-shaped receiving housing 17 which is open toward said covering cap 6 and adapted to receive a gas bag 16, an edge of said receiving housing 17 having extensions 17 (Fig. 2) projecting laterally outwards and toward said edge 24 of said covering cap 6, said guides 10 or 10,26 being provided on said extensions 17.

Regarding claim 4, said guides 10 or 10,26 are bolts 10 or 10,26 which are formed in one piece on said receiving housing 17.

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Regarding claim 6, a detent connection 29 is provided between said skeleton 1-3 and said gas bag module 5 to support said gas bag module 5. See line 49 et seq., column 3 of Pat.'012.

Regarding claim 7, restoring springs 15 are provided, said guides are bolts 10 or 10,26 which extend through said restoring springs 15.

Regarding claim 8, bearing bushes 13 are provided, said guides are bolts 10 or 10, 26 which are inserted in said bearing bushes 13, said bearing bushes 13 are mounted on said bolts 10 or 10, 26 so as to be nonremovable in said axial direction and are pressed into said foam casing 4.

Regarding claim 9, said guides 10 or 10,26 are received in said covering cap 6 so as to have inherently no lateral play (Figs. 1-3).

Regarding claim 10, said module 5 has a front side and said covering cap 6 covers said module 5 entirely on said front side (Figs. 1 and 2).

Regarding claim 11, said guides 10 or 10, 26 are not directly connected with each other as seen in Fig. 2.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
12. Claim 5, as best understood, is rejected under 35 U.S.C. 103(a) as obvious over Bohn et al. (EP 0 945 310 A2).

Regarding claim 4, Bohn teaches to form the guides of suitable synthetic material (see lines 21-31, column 4 of Pat. '012).

It is common knowledge in the art to form both Bohn's receiving housing and Bohn's guides of plastic in order to save additional weight. Plastic is a notoriously well known material in the art of steering wheel as evidenced by Bohn's teachings. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form both Bohn's receiving housing and Bohn's guides of plastic in order to save additional weight as suggested by common knowledge in the art.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Schutz'698 A1 (guides 16), Abe'709 A1 (guides 23), Wawra et al. (Fig. 2), Bohn'615 B1 (Fig. 1), Derrick et al.'473 B1 (guides 49), and Mirone'379 B1 (Figs. 1-10).

14. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-7687. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which

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applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

April 12, 2003



Vinh T. Luong
Primary Examiner